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HOFER
GILSON
& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: SANDERS et al.

Appln. No.: 09/954,506

Filed: September 14, 2001

For: METHOD AND APPARATUS FOR
ASSEMBLING REFASTENABLE
ABSORBENT GARMENTExaminer: Piazza Corcoran,
Gladys Josefina

Art Unit: 1733

Attorney Docket No.: 659-877

Client Ref. No.: 16569

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Appellants' Reply Brief
☒ Return Receipt Postcard

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- ☒ No additional fee is required.
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					Small Entity			Not a Small Entity	
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First Presentation of Multiple Dep. Claim					+\$180=			+ \$360=	
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☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

Andrew D. Stover (Reg. No. 38,629)

March 7, 2006

Date



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**BRINKS
HOFFER
GILSON
& LIONE**

Our Case No. 659/877
K-C Ref. No. 16,569

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Sanders, et al.

Serial No.: 09/954,506

Filing Date: September 14, 2001

For: METHOD AND APPARATUS FOR
ASSEMBLING REFASTENABLE
ABSORBENT GARMENT

Examiner: Piazza Corcoran, Gladys Josefina

Group Art Unit No.: 1733

APPELLANTS' REPLY BRIEF

MS APPEAL BRIEF - PATENTS
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer mailed January 11, 2006, please consider the following additional remarks.

1. Claims 1-31 Are Not Obvious Over UK Patent application GB 2 308 290 A to Fernfors in view of Japanese reference JP 03176053 to Takao, as further taken with USP 5,476,702 to Datta, USP 5,224,405 to Pohjola and/or USP 5,556,504 to Rajala

The Examiner has again erroneously and repeatedly asserted that Fernfors does not make any “particular disclosure on the specifics of applying the fastener material to the web” (Answer at 8 and 14). Applicants fundamentally disagree with this assertion, which provides the entire foundation for the Examiner’s rejection of claim 1.

Fernfors *does* provide a “particular disclosure on the specifics of applying the fastener material to the web,” but that disclosure teaches *away* from the asserted combination of references as applied by the Examiner. It is important to remember in this regard that Applicants are not presently arguing that the references, if combined, might or might not disclose all of the limitations of the claims, but rather that there is no suggestion to make the combination in the first place as is required under 35 USC 103 to make out a prima facie case of obviousness (MPEP 2143).

Specifically, the entire premise of Fernfors is based on the fastener strips 8 and 13 having a material surplus 9, 14, or loop, formed above the line of separation, which results in a gap being left beneath the surplus 9, 14 (Fernfors at page 7, lines 8-24; FIG. 1). During the manufacturing process, the lines of separation are broken, with the surplus material 9,14 flattening out by the application of a tensile force (Fernfors at page 8, lines 5-10). The first and second strips remain intact, since they are not subject to any excessive tension due to the surplus material that was provided (Fernfors at page 8, lines 5-10). Accordingly, Fernfors

teaches that it is absolutely necessary for the fastener strips to have a surplus loop of material.

As previously explained by Applicants in their main brief, Datta, Pohjola or Rajala do not disclose or suggest an apparatus or method for engaging and transferring a strip having a loop of surplus material, especially when the surplus material is *facing towards*, and would necessarily have to be engaged by, the engaging surface of the transfer apparatus. Rather, the devices of those references engage flat members, for example by way of a vacuum – there is no teaching that the devices can engage a surface having a loop or surplus material (see Datta at Col. 12, lines 25-41 (“the platens can slidably rotate on the surface of the vacuum plates while applying a vacuum pressure to the loop material 60”) and Fig. 6; see Pohjola at Col. 6, lines 20-39 (web strips 18 and 20 adhered by vacuum) and Fig. 4; see Rajala at Col. 19, lines 27-31 (suction applied to discrete parts)). Indeed, the vacuum disclosed by all three references would remove the surplus material facing towards the engaging surface, and there is no teaching of how to accommodate such material.

Accordingly, there is no suggestion to combine the references.

The Examiner’s response to this argument further reveals the classic hindsight analysis being used to make the asserted combination. In particular, the Examiner asserts that “one of ordinary skill in the art, looking at the references as a whole would readily recognize forming the die or platen [of Datta, Pohjola, and/or Rajala¹] with an indent in the

¹ Applicants note that Rajala discloses a transport head with an arcuate top wall 212 and spaced apart taking sections 218 (Col. 18, lines 20-27; FIG. 11). The Examiner has never asserted, rightly so, that the taking heads 218 in combination could accommodate a single strip 8. Firstly, Rajala discloses that each taking head 218 separately supports a respective strip, which lies flat along its surface. Second, such an analysis would eviscerate claim 2, since the heads could not accommodate two strips and Applicants would have argued the patentability of claim 2 separately

location of the surplus material in order to apply the strips in Fernfors, only the expected results would be attained” (Answer at 17). Applicants respectfully disagree.

As a threshold matter, the “fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness” (MPEP 2143.01). In other words, the level of skill in the art cannot be relied upon to provide the suggestion to combine the references (*id.* Citing *Al-Site Corp. v. VIS Int’l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161, (Fed. Cir. 1999). Such boot strapping first assumes that Fernfors suggests some desirability of rotating the fastener material, but Fernfors is totally lacking and teaches against such rotation, which makes it more difficult to form the surplus material.

Moreover, this same analysis applies to the strip 5 of Fernfors.² There simply is no suggestion in Fernfors to rotate the strip 5, regardless of whether the other references disclose such a capability. Indeed, Rajala, Datta and Pohjola disclose rotation so as to reorient *a pair* of strips or components (Rajala at FIG. 8; Col. 20, lines 5-49; Pohjola at Fig. 1, Col. 4, lines 4-10; Datta at FIGS. 2 and 6, Col. 12, lines 27-42). In contrast, the strip 5 of Fernfors is applied to only one side of the garment (compare Pohjola), is not elongated in the cross-direction (compare Rajala) and is not oriented at some oblique angle (compare Datta). Accordingly, one of ordinary skill in the art would not be motivated when looking at Pohjola, Datta or Rajala to

if such a position had been taken. Moreover, the taking heads 218 are aligned parallel with the discrete parts 132, not perpendicular thereto, as the discrete parts are introduced to the head (*id.*). There is no disclosure or suggestion in Fernfors, Rajala, or any of the references, however, that the surplus material of strip 8 could or would be formed in the longitudinal direction as the material is introduced to the taking heads. Simply put, Fernfors does not suggest and in fact teaches against rotating the fastener material, with its surplus material, regardless of whether it could be done.

² As set forth in the opening brief, Appellants dispute that the strip 5 is a “fastener material” as recited in claim 1.

rotate the strip 5 of Fernfors. Moreover, Fernfors discloses that the strip 5 may be *pre* or post configured with a *cross-direction* line of weakness (Fernfors at 6, lines 19-25), thereby further teaching against rotating the strip.

The Examiner has further asserted that there is no recitation in claim 1 that would “require the [fastener material] to be oriented in any particular fashion” (page 18), and that “there is no teaching against rotation of the strip material in Fernfors” (page 19). Such assertions are irrelevant, if not wrong.

With respect to the first statement, Applicants are not presently asserting that the references do not teach all of the limitations if combined, but rather that there is no suggestion to make the combination. With respect to the second statement, it is the Examiner’s burden to demonstrate that there is some suggestion to make the modification, not that the reference has some affirmative teaching against.

Moreover, the Examiner is wrong as explained above, Fernfors does teach against such rotation by disclosing the surplus material. Such material would be difficult to form in the longitudinal direction, is not accommodated by any rotation device and is not easily cut perpendicular to and across the surplus material, all of which lead to the inescapable conclusion that the strips 5, 8 of Fernfors are not rotated, but rather are applied in the machine direction.

Finally, Applicants note that the Examiner apparently concedes that the strip 5 does not form the fastener member that “releasably” engages one of the front or rear panel webs as recited in claim 15 (Examiner’s Answer at 10). Accordingly, claim 15 is further distinguished over the applied references when the fastener member is formed only of strip 8, as previously explained with respect to claim 1.

2. Claims 32, 34-41, 45, 48 and 49 Are Not Obvious Over USP 5,556,504 to Rajala in view of USP 5,499,219 to Roessler and/or USP 5,900,101 to Justmann

The Examiner asserts that “Roessler and/or Justmann are cited to show examples of forming two streams of fastener material by cutting one web of fastener material and separating the cut web into two streams of fastener material in order to reduce waste” (Examiner’s Amendment at 20). The Examiner further asserts that “Rajala does not have to disclose what orientation the fasteners could have to meet the limitations of the claims” (Examiner’s Amendment at 21). Such arguments miss the point.

As pointed out in Applicants’ opening brief, Justmann and Roessler do not suggest and teach against rotating the fasteners once they are separated but before applying them to another web. Indeed, if the fasteners were rotated, the garments of Justmann and Roessler would be rendered inoperable. Simply put, those references, when viewed as a whole, fail to suggest any rotation of the fasteners.

Conversely, Rajala does not provide any motivation for incorporating the fastener webs of Justmann or Roessler. While Rajala generally refers to discrete elements as including various fasteners, Rajala does not disclose what orientation such fasteners would have, if they formed the web 136, relative to the substrate web 134 prior to rotation, or what orientation the fasteners would have, if they were configured as the discrete parts 132, relative to the substrate web after rotation. In other words, Rajala does not disclose that the fasteners, if making up the webs 136, are oriented as taught by Justmann or Roessler. Again, the Examiner is confusing the requirements of making out a prima facie case of obviousness – Applicants are not presently arguing that all of the limitations are taught by the combined

references, but rather that the references, when viewed in their entirety, teach against rotating streams of fasteners as oriented therein.

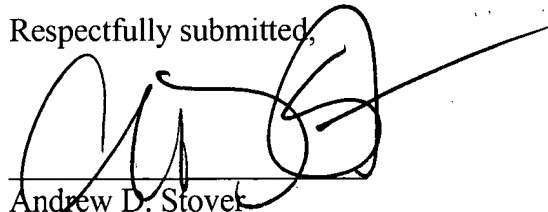
3. Claims 32 and 41-47 Are Not Obvious Over UK Patent application GB 2 308 290 A to Fernfors in view of EP 0755238 to Widlund and USP 5,556,504 to Rajala in view of U.S. Patent No. 5,499,219 to Roessler and/or U.S. Patent No. 5,900,101 to Justmann

In her Answer, the Examiner asserts that it is known to provide two separate fasteners as an equivalent to applying one fastener as shown by Widlund. This assertions ignores the entire premise of Fernfors, which discloses the necessity of *bridging* the gap, such that the fastener material 8, 13 can then be welded and subsequently cut (Fernfors at page 8, line 5 to page 9, line 12). Accordingly, there also is no suggestion to combine Widlund with Fernfors.

4. Conclusion

The cited references do not provide a valid basis for a *prima facie* obviousness rejection of the present claims. Accordingly, Appellants submit that the present invention is fully patentable over the cited references, and the Examiner's rejections should be REVERSED.

Respectfully submitted,



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